

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF

BRENNEISEN ET AL.

APPLICATION NO: 10/580,186

PCT No. PCT/EP04/013413

FILED: November 25, 2004

FOR: PLANT EXTRACTS FOR THE TREATMENT OF INCREASED BONE
RESORPTION

MAIL STOP PCT

Commissioner for Patents

PO Box 1450

Alexandria, VA 22313-1450

RESPONSE TO DECISION

Sir:

The Decision mailed April 2, 2007, (a copy of which is enclosed) has a shortened statutory time set to expire on June 2, 2007.

A four-month extension is hereby requested pursuant to 37 CFR §1.136(a) in a Petition for Extension of Time. Please charge Deposit Account No. 19-0134 in the name of Novartis in the amount of \$1590 for payment of the extension fee as stated on the enclosed Petition for Extension of Time.

In response, Applicant submits:


1. Substitute Declaration and Power of Attorney for U.S. Patent Applications (12 sheets);
2. Supplemental Declaration and Power of Attorney for U.S. Patent Applications which includes a statement under 37 C.F.R. §1.497(d) that any error in inventorship in the international application occurred without deceptive intention on his or her part (3 sheets);
3. The processing fee set forth in 37 C.F.R. §1.17 in which the Commissioner is authorized to charge the fee of \$200.00 to Deposit Account No. 19-0134 in the name of Novartis; and
4. To our knowledge, an assignment has not been executed by any of the original named inventors.

Applicant requests correction of the inventorship to add inventor Rudolf Brenneisen as a joint inventor to the above-referenced application, which was previously added in co-pending PCT Application No. PCT/EP2004/013413 (PCT Publication No. WO 2005/051409 A1).

The Commissioner is hereby authorized to charge any additional fees under 37 CFR §1.17 which may be required, or credit any overpayment, to Account No. 19-0134 in the name of Novartis.

Respectfully submitted,

Novartis
Corporate Intellectual Property
One Health Plaza, Building 104
East Hanover, NJ 07936-1080
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Date: September 21, 2007



02 APR 2007

Commissioner for Patents
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NOVARTIS
CORPORATE INTELLECTUAL PROPERTY
ONE HEALTH PLAZA 104/3
EAST HANOVER, NJ 07936-1080

In re Application of
Brenneisen et al.
Application No.: 10/580,186
PCT No.: PCT/EP04/13413
Int. Filing Date: 25 November 2004
Priority Date: 26 November 2003
Attorney Docket No.: 33276-US-PCT
For: Plant Extracts For The Treatment
Of Increased Bone Resorption

DECISION

This is a decision on the correspondence filed on 26 July 2006, which is being treated as a request to correct inventorship under 37 CFR 1.497(d).

BACKGROUND

This international application was filed on 25 November 2004, claimed an earliest priority date of 26 November 2003, and designated the United States. The International Bureau (IB) transmitted a copy of the published international application to the USPTO on 09 June 2005. Consequently, the thirty month period for payment of the basic national fee in the United States expired as of midnight on 26 May 2006. On 22 May 2006, applicants filed *inter alia* the basic national fee.

DISCUSSION

The declaration of the inventors filed on 26 July 2006 lists a joint inventor, Rudolf Brenneisen, who was not nominated in the published international application, nor is an appropriate Form PCT/IB/306 present in the application file. This declaration is being treated under 37 CFR 1.497(d). A declaration filed under 37 CFR 1.497(d) must be by the actual inventor or inventors as required under 37 CFR 1.63 or as permitted by 37 CFR 1.42, 1.43 or 1.47. The declaration must be accompanied by (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part, (2) the processing fee set forth in 37 CFR 1.17; and (3) if an assignment has been executed by any of the original named inventors, the written consent of the assignee (See 37 CFR 3.73(b)). See Section 201.03 of the Manual of Patent Examining Procedure (M.P.E.P.).

Regarding requirement (1), applicants have not provided an appropriate statement by Mr. Brenneisen.

Regarding requirement (2), the required processing fee is being charged to counsel's Deposit Account No. 19-0134, per the authorization included in the Transmittal Letter filed on 22 May 2006.

Regarding requirement (3), review of the record reveals that either Novartis AG and/or Universität Bern may enjoy an assignment interest in this international application, but applicants have not submitted the appropriate written consent of the assignee(s), along with appropriate 37 CFR 3.73(b) statement(s). Nor have applicants indicated that no assignment interest pertains to this application. As such, requirement (3) has not been satisfied.

CONCLUSION

The declaration is **NOT ACCEPTED** under 37 CFR 1.497(d), without prejudice.

If reconsideration on the merits of this matter is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a). Failure to timely reply will result in **ABANDONMENT** of this application. Any reconsideration request should include a cover letter entitled "Renewed Submission Under 37 CFR 1.497(d)". No additional processing fee is required.

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the Office of PCT Legal Administration.



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